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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/988,836	11/19/2001	Thomas M. Sirhall	SMQ-062	9387
959	7590	04/29/2005	EXAMINER	
LAHIVE & COCKFIELD, LLP. 28 STATE STREET BOSTON, MA 02109			HUTTON JR, WILLIAM D	
			ART UNIT	PAPER NUMBER
			2179	
DATE MAILED: 04/29/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/988,836	SIRHALL, THOMAS M.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Doug Hutton	2179	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

**A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.**

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) Responsive to communication(s) filed on 27 January 2005.
- 2a) This action is **FINAL**.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-20 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 19 November 2001 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                    | Paper No(s)/Mail Date. _____.   |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____. | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|   | 6) <input type="checkbox"/> Other: _____.                                   |

***Applicant's Response***

In Applicant's Response dated 27 January 2005, Applicant amended Claims 1, 7, 9, 13-15 and 19, and argued against all objections and rejections previously set forth in the Office Action dated 27 October 2004.

The objections to Claims 7, 14, 15 and 19 previously set forth are withdrawn.

***Claim Objections***

Claims 1, 9 and 13 are objected to because of the following informalities:

- the phrase "a user" in Claim 1, Line 6 should be amended to — the user — because the "user" is previously recited in the claim (see Claim 1, Line 4); Claims 9 and 13 have the same problem.

Claim 15 is objected to because of the following informalities:

- the phrase "markup language include " in Lines 1-2 should be amended to — markup language document includes — because that is how the element is previously identified (see Claim 14, Line 2) and so that the claim reads more easily.

Appropriate correction is required.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-20 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Rukavina et al., U.S. Patent Application Publication No. US 2002/0188583, in view of Carroll, U.S. Patent No. 6,762,777.

***Claim 1:***

Rukavina discloses, in an electronic device in a distributed network, a method practiced by an online educational facility (see Figures 1 and 3-5; see Page 2, Paragraphs 0012 and 0017 – Rukavina discloses this limitation in that the e-learning system is used to create, maintain and deliver course content to a student), comprising the steps of:

- providing a web page with an embedded software facility as part of an online educational course, wherein said software facility displays text to a user (see Figures 3-5; see Page 4, Paragraph 0044 through Page 5, Paragraph 0053 – Rukavina discloses this limitation in that the e-learning system generates course content dynamically and delivers the content to the student in the form of web pages, wherein the course web pages are comprised of a collection of objects that represent various components within the e-learning system; thus, the e-

learning system can generate custom course content to meet the needs of any student);

- receiving a request for the web page from a user (see Page 2, Paragraph 0017 – Rukavina discloses this limitation in that the e-learning system allows the student to request the course web pages); and
- transmitting the web page to the user in response to the request (see Figures 3-5; see Page 2, Paragraph 0017 – Rukavina discloses this limitation in that the e-learning system the course web pages requested by the student).

Rukavina fails to expressly disclose a software facility that enables a user to create a popup message associated with the text that is displayed to the user.

Carroll teaches in an electronic device in a distributed network, a method, comprising the step of:

- providing a web page with an embedded software facility, wherein said software facility enables a user to create a popup message associated with text that is to be displayed to the user (see Figure 1; see Column 3, Lines 5-11; see Column 4, Lines 6-9 – Carroll discloses this limitation in that, when the user moves his cursor over the highlighted region of electronic text, a popup window appears; as expressly taught by Carroll, a scripting agent may be used to provide the resulting popup window; the “scripting agent” is the “embedded software facility”),

for the purpose of adding comments or expanding a description of a particular section of the web page (see Column 1, Lines 22-29).

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method, disclosed in Rukavina, to include:

- providing a web page with an embedded software facility, wherein said software facility enables a user to create a popup message associated with text that is to be displayed to the user,

for the purpose of adding comments or expanding a description of a particular section of the web page, as taught by Carroll.

*Claim 2:*

Rukavina discloses a software facility that is an applet (see Page 3, Paragraphs 0035-0036 – Rukavina discloses this limitation in that the e-learning system includes learning objects in an object-oriented environment).

*Claim 3:*

Rukavina discloses a web page that is an HTML document (see Page 1, Paragraph 0007 – Rukavina discloses this limitation, as clearly indicated in the cited text).

*Claim 4:*

Rukavina discloses a web page that is an XML document (see Page 1, Paragraph 0008 – Rukavina discloses this limitation, as clearly indicated in the cited text).

*Claim 5:*

Rukavina discloses a software facility that is automatically executed after being transmitted to the client (see Figure 1; see Page 3, Paragraph 0030 – Rukavina discloses this limitation in that the e-learning system includes a dynamic delivery tool that delivers content to the user and monitors the user's interactions with the web page in order to respond to subsequent requests by the user).

*Claim 6:*

Rukavina discloses a software facility that executes in a web browser environment (see Figures 1 and 7; see Page 6, Paragraph 0063 – Rukavina discloses this limitation, as clearly indicated in the cited figures and text).

*Claim 7:*

Rukavina discloses a software facility that performs the following step when the software facility executes:

- receiving the text (see Figures 3-5; see Page 2, Paragraph 0017 – Rukavina discloses this limitation, as clearly indicated in the cited figures and text).

Rukavina fails to expressly disclose:

- defining at least one outlined area in the text where the popup message will appear; and
- tracking movement of a cursor and displaying the popup message when the cursor enters the at least one outlined area.

Carroll teaches a software facility that performs the following step when the software facility executes:

- defining at least one outlined area in the text where the popup message will appear (see Figure 1; see Column 3, Lines 5-11 – Carroll discloses this limitation in that the text display system includes a highlighted region of electronic text); and
- tracking movement of a cursor and displaying the popup message when the cursor enters the at least one outlined area (see Figure 1; see Column 3, Lines 5-11 – Carroll discloses this limitation in that the text display system displays the popup window when the cursor is in the highlighted region, and, when the cursor moves outside the highlighted region, the popup window disappears),

for the purpose of adding comments or expanding a description of a particular section of the web page (see Column 1, Lines 22-29).

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method, disclosed in Rukavina, to include:

- defining at least one outlined area in the text where the popup message will appear; and
- tracking movement of a cursor and displaying the popup message when the cursor enters the at least one outlined area,

for the purpose of adding comments or expanding a description of a particular section of the web page, as taught by Carroll.

*Claim 8:*

Rukavina discloses text that is sections of computer programming code (see Figure 3; see Page 4, Paragraph 0044 – Rukavina discloses this limitation in that the e-learning tool displays an online course on Java programming language).

*Claims 9-12:*

Claims 9-12 merely recite computer software that performs the methods of Claims 1-4, respectively. Thus, Claims 9-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rukavina, in view of Carroll, as indicated in the above rejections for Claims 1-4.

*Claims 13, 14 and 16-20:*

Claims 13, 14 and 16-20 merely recite a computer that performs the methods of Claims 1, 3, 2 and 5-8, respectively. Thus, Claims 13, 14 and 16-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rukavina, in view of Carroll, as indicated in the above rejections for Claims 1, 3, 2 and 5-8.

*Claim 15:*

Rukavina discloses markup language that includes executable content for viewing images (see Figure 5; see Page 5, Paragraph 0051 – Rukavina discloses this limitation, as clearly indicated in the cited figure and text).

***Response to Arguments***

Applicant's arguments filed 27 January 2005 have been fully considered but they are not persuasive.

*Arguments for Claims 1, 9 and 13:*

Applicant argues that Rukavina and Carroll fail to disclose or suggest "providing a web page with an embedded software facility as part of an online educational course, wherein said software facility enables a user to create a popup message associated with text that is to be displayed to the user" because: 1) the examiner admits that Rukavina does not suggest a software facility that enables a user to create a pop-up

message associated with the text that is displayed to the user; and 2) Carroll does not make any mention of an embedded software facility. Instead, Applicant argues, Carroll discloses inserting **tags** into a document to link to pop-up windows and Carroll does not mention a “software facility” embedded in the document to perform this function (emphasis added). See *Applicant’s Response* – Page 7, third and fourth full paragraphs.

The examiner disagrees.

Firstly, the Specification of the present invention does not limit the “embedded software facility” to a script or an applet. Thus, the phrase “embedded software facility” reads broadly and may include the “hardcoded” portion of a web page.

Carroll teaches inserting tags into a web page document so that a popup message appears when a user moves the cursor over a particular region of text within the document. These tags comprise an “embedded software facility” in that the tags of code for executing the popup windows whenever the user moves the cursor over the corresponding region of text within the document.

Secondly, as indicated in the above rejection for Claim 1, Carroll does teach “providing a web page with an embedded software facility, wherein said software facility enables a user to create a popup message associated with text that is to be displayed to the user” in that, when the user moves his cursor over the highlighted region of electronic text, a popup window appears (see Figure 1; see Column 3, Lines 5-11). Also, a scripting agent may be used to provide the resulting popup window (see Column 4, Lines 6-9).

Accordingly, Rukavina, in view of Carroll, discloses/teaches "providing a web page with an embedded software facility as part of an online educational course, wherein said software facility enables a user to create a popup message associated with text that is to be displayed to the user."

Applicant argues that there is no suggestion or motivation to modify or combine Rukavina and Carroll. Applicant supports the argument by pointing out perceived differences between the inventions disclosed in Rukavina and Carroll. Applicant concludes the argument by stating that combining Carroll with Rukavina would undermine the functionality of Rukavina and, thus, there is no reasonable expectation of success in combining Rukavina and Carroll. See *Applicant's Response* – Page 8, first full paragraph.

The examiner disagrees.

Firstly, the examiner did provide motivation to combine Rukavina and Carroll in the Office Action dated 27 October 2004 (see Office Action – Page 4, second full paragraph – "for the purpose of adding comments or expanding a description of a particular section of the web page"). Applicant fails to acknowledge the motivation provided by the examiner and does not address it in the argument.

Secondly, both Rukavina and Carroll are inventions in the field of web page creation and use. As indicated in the above rejection for Claim 1, Rukavina discloses web page use for an online educational facility and Carroll teaches web page use involving popup windows. It would have been obvious to one of ordinary skill in the art

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(e.g., a web page author) at the time the invention was made to combine the popup windows taught in Carroll with ANY web page for the purpose of adding comments or expanding a description of a particular section of the web page.

Moreover, the popup window taught in Carroll is used for educational purposes. See Figure 1 of Carroll, where the popup window informs the user that "foxes are brown short-haired animals." Thus, it certainly would have been obvious to one of ordinary skill in the art at the time the invention was made to use the popup windows taught in Carroll on an educational website.

Accordingly, there is motivation to combine Rukavina and Carroll, and there is a reasonable expectation of success in combining Rukavina and Carroll.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Doug Hutton whose telephone number is (571) 272-4137. The examiner can normally be reached on Monday-Friday from 8:00 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon, can be reached at (571) 272-4136. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-2100.

WDH  
April 22, 2005

  
HEATHER R. HERNDON  
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